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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,044	12/18/2001	Petrus Cornelis Jozef Beenjes	APV 31519	7831

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EXAMINER

NOLAN, SANDRA M

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 09/09/2003

*Handwritten signature/initials*

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/936,044

Applicant(s)

BEENTJES ET AL.

Examiner

Sandra M. Nolan

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2003 and 21 July 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 and 30-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 and 30-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claims***

1. Claims 1-28 and 30-44 are pending.

### ***Rejections Withdrawn***

2. The 35 USC 112 rejection of claims 1-37 as indefinite, as set out in section 3 of the 01 April 2003 office action (Paper No. 7), is withdrawn in view of the amendments in the response dated 21 July 2003 (Paper No. 10).
3. The 35 USC 102 rejection of claims 1-7 as anticipated by Dallmann et al (US 4,746,703), as recited in section 5 of Paper No. 7, is withdrawn in view of the amendments and arguments in Paper No. 10.
4. The 35 USC 102 rejection of claims 1-14 as anticipated by Goss et al (EP 0437942 A2), as expressed in section 6 of Paper No. 7, is withdrawn in view of the amendments and arguments in Paper No. 10.
5. The 35 USC 103 rejection of claims 1-22 and 33-34 as unpatentable over Woud et al (WO 98/37159) in view of Goss, as presented in section 9 of Paper No. 7, is withdrawn in view of the amendments and arguments in Paper No. 10.
6. The 35 USC 103 rejection of claims 23-32 and 35-37 as unpatentable over Schmook (DE 36510379A) in view of Woud and Goss, as discussed in section 10 of Paper No. 7, is withdrawn in view of the amendments and arguments in Paper No. 10.

**New Objection and Rejections**

***Specification***

7. The amendment filed on 21 July 2003 (Paper No. 10) is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The material which is not supported by the original disclosure is found at page 1, line 5, and reads as follows: "(or in other words, "film")".

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-28 and 30-44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This is a new matter rejection.

The term "film", as now recited in various claims, including claims 1, 15 and 30, is not supported by the original specification.

Applicants must either show where the term is supported in the original specification or cancel it from the claims.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 17-20 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

How many layers do the laminates of these claims have?

Please clarify.

11. Claims 36 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

What is "a PVC-containing compound"?

Please clarify.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claims 1-6, 8-28 and 30-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 04007142 A (abstract) in view of JP 04353443 A (abstract).

JP 04007142 A ("JP '142") teaches laminating a metal substrate melt with a thermoplastic adhesive resin and a PVC resin (title). The adhesive resin contains a saturated polyester resin (second paragraph, third sentence). The adhesive resin and the PVC are coated on the metal by coextrusion (second paragraph, last sentence).

JP '142 fails to teach the blend of polyesters recited in applicants' claims.

JP 04353443 A ("JP '443") teaches coating metal plates with blends of 5-95% crystalline- and 5-95% non-crystalline polyesters (first paragraph). The crystalline polyester is polyethylene terephthalate (PET), polybutylene terephthalate or polyethylene naphthalate; the non-crystalline polyester is a PET copolymer containing 30 mol. % cyclohexane dimethanol (third paragraph). The coated metal has good workability, high adhesion and impact resistance (Advantage section).

The references are analogous because they both deal with metals coated with polyester resins.

It would have been obvious to one having ordinary skill in the art at the time that the invention was made to employ the polyester blends of JP '443 in the adhesive layers used in the process of JP '142 in order to make laminated metal products having good workability, high adhesion and impact resistance.

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The motivation to employ the blends of JP '443 in the process of JP '142 is found in the Advantage section of the JP '443 abstract, where the good workability, high adhesion and impact resistance of its coated metal products are discussed.

It is deemed desirable to make metal products having good workability, high adhesion and impact resistance in order to insure that the products will be machineable, printable and have acceptable useful lives.

***Response to Arguments***

15. Applicant's arguments with respect to claims 1-28 and 30-44 have been considered but are moot in view of the new ground(s) of rejection.

***Final Rejection***

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

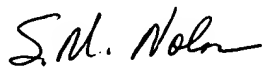
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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**Conclusion**

Any inquiry concerning this communication should be directed to the Examiner, Sandra M. Nolan, whose telephone number is 703/308-9545. The Examiner can normally be reached on Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the Examiner by telephone are unsuccessful, her supervisor, Harold Pyon, can be reached at 703/308-4251. The general fax number for the art unit is 703/872-9306. The receptionist answers 703/308-0661.



S. M. Nolan  
Patent Examiner  
Technology Center 1700

SMN/smn  
09936044(11)  
02 September 2003